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In re Application of
Randall F. Alder et al
Application No. 10/707,675
Filed: December 31, 2003
Attorney Docket No.: 60680-1814
For: HOSE AND TUBE ASSEMBLY

:
: **DECISION ON PETITION**
: **REGARDING RESTRICTION**
: **REQUIREMENT**
:
:

Applicants' petition filed on June 21, 2005 requests withdrawal of the election requirement as set forth in the Office action mailed February 14, 2005 and thereafter made final in the Office action mailed March 22, 2005. Applicants further request an examination on the merits of all pending claims.

The petition is **DENIED**.

A review of the record reveals that the Office action mailed February 14, 2005 set forth an election requirement requiring a provisional election between four species identified as (1) Fig. 1, (2) Fig. 2, (3) Figs. 3 and 5, and (4) Fig. 4. Applicants elected the species of Fig. 1 with traverse in the response filed March 4, 2005. The examiner, upon reconsideration, adhered to the election requirement and made the election requirement final. This petition was then timely filed.

Applicants' petition alleges that the election requirement is improper because there is significant overlap between the claims of the identified groups of invention due to the presence of generic claims and that the subject matter is sufficiently related such that a thorough search for the subject matter of the elected species would encompass a search for the subject matter of the other species. As a result, it is alleged that no serious burden on the examiner exists. Applicants' further allege that the examiner failed to explain how and why the various figures were grouped as indicated in the election requirement of February 14, 2005 and the "present invention" is directed to the inclusion of grooves possessing a predetermined width of the groove opening being generally less than the predetermined width of the groove base.

At the outset, it appears from applicants' arguments that applicants have not analyzed the examiner's action in the context of the established practice for requiring a provisional election of species requirement as established in Chapter 800 of the MPEP. In particular, it is a well-

established practice that a requirement to elect a single disclosed species is a holding by the examiner that the plural species, as claimed, are patentably distinct, i.e., capable of supporting separate patents, see MPEP 808.01(a) and MPEP 809.02(a). If applicants are of a different view, then applicants need merely clearly state on the record that the species are not patentably distinct. Neither the examiner nor applicants need to present any reasoning.

With respect to applicants' allegation that the examiner failed to explain how and why the figures were grouped as indicated, it should be noted that the examiner fully complied with Office procedure and practice, see MPEP 809.02(a), by clearly identifying each species by the figures. Further, it is readily apparent from a review of the various figures for each identified species that species I is drawn to an arrangement having one type of coupling mechanism and including grooves of constant width from the groove opening to the groove base, i.e., groove walls perpendicular to the groove base; that species II is drawn to an arrangement having a second type of coupling mechanism and grooves of constant width from the groove opening to the groove base; that species III is drawn to an arrangement having a third type of coupling mechanism and including a second configuration for the grooves wherein the width of the groove opening is generally less than the width of the groove base, i.e., full dovetail; and that species IV is drawn to an arrangement having a coupling mechanism with a third configuration for the grooves, i.e., partial dovetail. Accordingly, it is evident that the examiner has identified patentably distinct species along the lines of the different coupling mechanism and groove configuration.

Applicants' assert that the examiner incorrectly states that Figs. 1 and 2 do not include grooves having a groove opening width that is generally less than the width of the groove base. Applicants' then point to numerous parts of the disclosure as support for their assertion that all variations of the present invention possess grooves having a groove opening width that is generally less than the width of groove base. While various parts of the written disclosure and several figures discuss/illustrate this particular groove configuration, Figs. 1 and 2 clearly do not illustrate this and none of the written disclosure discusses groove configuration with specific reference to Figs. 1 and 2. There is no explicit description that discloses that the grooves of Figs. 1 and 2 are of dovetail or partial dovetail configuration, i.e., possess a groove opening width that is generally less than the width of the groove base. The specific discussion of groove configuration comes only with reference to Figs. 4 and 5. Note paragraph 0024. It is further noted that paragraph 0015 states that the second member includes "various embodiments" and then proceeds to state that Figs. 1 and 2 show a first variation while Fig. 3 shows a second alternative. Paragraph 0019 provides a discussion of minimum width dimension and minimum depth dimension but does not discuss having the width of the opening generally less than the width of the base. Finally, paragraph 0027 states that the description of the present invention is illustrative and not limiting, many embodiments are apparent and the scope of the invention is to be determined with reference to the claims. Accordingly, it is evident that applicants contemplate as their invention arrangements that include grooves not limited to only those having the width of the opening being generally less than the width of the base. This is evidenced by the showing of planar groove walls that extend perpendicularly to the base provided by Figs. 1 and 2 as well as the scope of original independent claim 11, which encompasses the constant width grooves presently illustrated in Figs. 1 and 2.


Finally with respect to Figs. 1 and 2, it is noted that there has been no assertion on the part of applicants that the illustration of the grooves is not correct or accurate nor has there been any attempt to correct the illustration of these figures. To the contrary, applicants state that Figs. 1 and 2 show the angle of the groove walls to the base to be "generally *slightly* less than ninety (90) degrees" (emphasis by applicants). This statement, with emphasis on the word "slightly", is not understood. Is it applicants' position that the illustration is so slight that it cannot be perceived? Nevertheless, Figs. 1 and 2 illustrate and convey that the groove walls extend perpendicularly from the base and nothing in the written description relating specifically to the discussion of these figures contradicts this.

With respect to the alleged presence of generic claims, it should be noted that the presence or absence of generic claims is not indicative of the propriety of an election requirement. A generic claim must be found to be allowable before there is any impact on a provisional election requirement, see MPEP 809.02(b) and MPEP 809.02(c). Further, note MPEP 806.04(d) for the definition of what constitutes a generic claim.

With respect to the allegation of a coextensive search, applicants have failed to show that a coextensive search is a reason for not requiring an election requirement. Further, applicants have failed to show that search is the only criteria for determining "serious burden" on the part of the examiner. Nevertheless, it should be noted that the search for and examination, including consideration of and response to arguments, of the various specific features of multiple patentably distinct species in the same application creates a serious burden on the examiner when no allowable generic claim is indicated to be present.

For the foregoing reasons, the examiner's provisional election requirement is proper.

The application is being forwarded to the examiner for consideration of the amendment filed June 21, 2005. An appropriate Office response will follow in due course.


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SNM/DS: 7/07/05

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